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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,003	02/28/2002	Dwight Marcus	0008016-0008	6290
23600	7590	09/09/2003		
COUDERT BROTHERS LLP 333 SOUTH HOPE STREET 23RD FLOOR LOS ANGELES, CA 90071			EXAMINER	
			ALAM, SHAHID AL	
			ART UNIT	PAPER NUMBER
			2172	
DATE MAILED: 09/09/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT PAPER

8

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Shahid Al Alam
Primary Examiner
Art Unit: 2172

Office Action Summary	Application No.	Applicant(s)
	10/087,003	MARCUS, DWIGHT
	Examiner Shahid Al Alam	Art Unit 2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 June 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-71 and 79-83 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-71 and 79-83 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s). _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 20 June 2003 have been fully considered but they are not persuasive for the following reasons.

Applicant's main argument is that Shimizu either alone or in combination with Hubbell failed to teach "automatically selecting a plurality of media elements . . .," as recited in Applicant's independent claims. Applicant also argues that Hubbell does not teach automatically selecting media elements in page 21 of argument.

Examiner respectfully disagrees the entire allegation as argued. Examiner, in his previous office action, gave detail explanation of claimed limitation and pointed out exact locations in the cited prior art.

Examiner maintains that Shimizu's teachings of a multi-media document editing system including a multi-media data storing means for storing a plurality of multi-media data elements, a multi-media document holding means for holding a multi-media document containing structural information on time and display position at the time of reproducing each element of the multi-media data stored in the multi-media data storing means, an editing means for editing to connect the structural information elements of the multi-media document through a link structure element, and a multi-media document reproducing means for reproducing each element of the multi-media data stored in the multi-media data storing means on the basis of the structural information of the multi-media document which has been edited by the editing means and the editing means *selects plural elements* to be subjected to the editing operation for the multi-media

document and then performs the editing operation for *the selected plural elements* while maintaining the relation between the elements clearly teaches Applicant's claimed invention.

Applicant agrees that Shimizu teaches manually selecting media elements on page 18 of argument. The teaching of Shimizu is done by a computer system, where as, the editing means selects plural elements to be subjected to the editing operation for the multi-media document and then performs the editing operation for the selected plural elements while maintaining the relation between the elements is equivalent to Applicant's selecting a plurality of media elements. However, Applicant now claiming that selection is done by automatically. Examiner wants to point out a case law, which teaches that an automatic means to replace a manual activity is not sufficient. See *In re Venner*.

In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed."

The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.)

Applicant argues that Hubbell does not teach automatically selecting media elements.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner uses Hubbell for different reason and not for automatically selecting media elements as wrongfully argued by the Applicant.

In view of the above, the examiner contends that all limitations as recited in the claims have been addressed in this Action.

For the above reasons, Examiner believed that rejection of the last Office action was proper.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 – 5, 8, 9, 11 – 15, 18, 19, 21 – 31, 36 – 37, 47, 50, 57 – 59, 67, 79 and 80 – 83 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 5,861,880 issued to Takeshi Shimizu et al. (“Shimizu”).

With respect to claim 1, Shimizu teaches a method of creating media programming, comprising:

maintaining a database containing selected information about each of a plurality of media elements; selecting a plurality of said media elements in response to a request for media programming, and selecting a temporal organization for said selected media elements, said temporal organization not being dictated by said selected information; and assembling said media elements into media programming (column 1, lines 8 – 16).

As to claim 2, said media elements are audiovisual clips, and said media programming is an audiovisual program (column 8, lines 24 – 52).

As to claim 3, said media elements are still photographs, and said media programming comprises a series of said still photographs (column 8, lines 24 – 52).

As to claim 4, said selected information comprises content information relating to said media assets (column 8, lines 24 – 52).

As to claim 5, said selected information comprises a plurality of tags associated with each of said media elements, at least one of said tags being a content tag containing information relating to content of said media element, and at least one of said tags being a control tag containing information other than content information (column 10, lines 43 – 67).

As to claim 8, said step of selecting further comprises selecting two elements based on said request, selecting a temporal order for said two elements, and determining based on information in said control tags whether said two elements may be assembled in the selected temporal order, and, if not, deselecting at least one of said two elements (column 11, lines 54 – 67 and column 12, lines 1 – 36).

As to claim 9, said step of selecting further comprises selecting two elements based on said request, selecting a temporal order for said two elements, and selecting transitions for said two elements based on transition information associated with each of said elements and transition rules (column 11, lines 54 – 67 and column 12, lines 1 – 36).

With respect to claim 30, Shimizu teaches a method of creating media programming from a plurality of stored media elements, comprising:

selecting from a database containing information concerning said media elements a plurality of said media elements and automatically designating a temporal sequence for said selected media elements; and automatically selecting transitions for each of said media elements (column 1, lines 8 – 16 and column 4, lines 16 – 31).

As to claim 31, said step of automatically selecting transitions comprises selecting transitions independently for a video portion of said element and for an audio portion of said element (column 14, lines 44 – 56).

As to claim 47, the step of obtaining desired content information concerning an intended view of a the programming prior to said step of selecting, and employing said desired content information in said step of selecting (column 8, lines 14 – 52).

As to claim 67, obtaining psychographics information concerning an intended view of a the programming prior to said step of selecting, and employing said psychographics information in said step of selecting (column 8, lines 14 – 52).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6, 7, 10, 16, 17, 20, 32 – 35, 38 – 46, 48, 49, 51 – 56, 60 – 66 and 68 – 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu and in view of U.S. Patent Number 5,966,121 issued to John Hubbell et al. ("Hubbell").

As to claims 6 and 7, Shimizu teaches all the limitations except that he does not explicitly teach control tags contains transition information and a luminance range for a portion of said media clip as claimed.

Hubbell teaches media element is a media clip, and at least one of said control tags contains transition information (column 10, lines 20 – 28; Hubbell) and at least one of said control tags contain a luminance range for a portion of said media clip (column 5, lines 9 – 25 and column 10, lines 20 – 28; Hubbell).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine Hubbell with Shimizu because combination would permit access to video editing format and to efficient modification of the data signal portion of a multimedia bit-stream (column 2, lines 54 – 61; Hubbell).

As to claims 42 and 43, said transition information comprises: a transition point and a transition type (column 9, lines 53 – 56; Hubbell).

As to claims 44 – 46, said transition type is a dissolve, a cut and a fade (column 7, lines 26 – 30 and column 14, line 65 – column 15, line 6: Hubbell).

As to claim 48, a modification parameter wherein said modification parameter is used to modify a transition (column 5, lines 17 – 25; Hubbell and column 16, lines 13 – 20; Shimizu).

As to claim 10, Shimizu teaches all the limitation except he does not explicitly teach the step of obtaining a demographic information as claimed.

Hubbell teaches the step of obtaining demographic information concerning an intended view of a the programming prior to said step of selecting, and employing said demographic information in said step of selecting (column 7, lines 8 –25; Hubbell).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine Hubbell with Shimizu because combination would permit access to video editing format and to efficient modification of the data signal portion of a multimedia bit-stream (column 2, lines 54 – 61; Hubbell).

It would have been obvious to a person of ordinary skill in the art to employing said demographic information in said step of selecting for statistical purposes.

As to claim 49, the step of obtaining desired style information concerning an intended view of a the programming prior to said step of selecting, and employing said desired style information in said step of selecting (column 4, line 66 – column 5, line 8; Hubbell and column 8, lines 14 – 52; Shimizu).

As to claim 66, assembling an automatically assembled media clip into said media programming (column 8, lines 24 – 52; Shimizu and column 1, line 63 – column 2, line 5; Hubbell).

As to claim 68, filtering a first media element out of consideration for inclusion in said media programming wherein said filtering is performed by a moderation layer (column 5, lines 17 – 25; Hubbell).

As to claim 69 - 71, at least one of said tags is a taxonomic tag, an attribute tag and a reusability tag (column 10, lines 20 – 28 and column 14, lines 10 – 16; Hubbell).

The subject matter of claim 32 is rejected in the analysis above in claims 5 and 6 and this claim is rejected on that basis.

The subject matter of claims 34 and 35 are rejected in the analysis above in claims 42 and 43 and these claims are rejected on that basis.

The subject matter of claims 33 and 60 – 62 are rejected in the analysis above in claims 44 – 46 and these claims are rejected on that basis.

Claims 11 – 22 and 50 – 56 are essentially the same as claims 1 – 10, 42 – 49 and 66 – 71 except that it sets forth the claimed invention as a system rather than a method and rejected for the same reasons as applied hereinabove.

The subject matter of claims 23 – 29 and 57 – 59 are rejected in the analysis above in claims 1 – 10, 42 – 49 and 66 – 71 and these claims are rejected on that basis.

The subject matter of claim 79 is rejected in the analysis above in claims 1 – 10, 42 – 49 and 66 – 71 and this claim is rejected on that basis.

The subject matter of claims 80 – 83 are rejected in the analysis above in claims 1 – 10, 42 – 49 and 66 – 71 and these claims are rejected on that basis.

Claims 36 – 41 and 63 – 65 are essentially the same as claims 30 – 35 and 60 – 62 except that it sets forth the claimed invention as a system rather than a method and rejected for the same reasons as applied hereinabove.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (703) 305-2358. The examiner can normally be reached on Monday - Thursday 8:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (703) 305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Shahid Al Alam
Primary Examiner
Art Unit 2172

September 6, 2003